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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,403	03/26/2004	Atsuko Mitsuba	0229-0798PUS1	7549

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/809,403	Applicant(s) MITSUBA, ATSUKO	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/26/2004</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: Highlight of US ('120) and US ('310).

DETAILED ACTION

This Office action is responsive to communication received 03/26/2004 – application papers filed; priority papers received, IDS, preliminary amendment.

Claims 1-14 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 5, 7, 8, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen ('310). Reference is made to the attached highlight of Figure 4 in Chen and the language in col. 2, lines 18-25. As to claim 1, note the indicated face wall (21), sole (22), backside wall and inclined frontward portion. As to claim 2, the drawing would appear to show a 60 degree angle between the inclined portion and the horizontal plane. As to claim 3, note that Chen indicates that the striking face is between 2 mm and 3.5 mm. Using this dimension as a guide, it is clear that the vertical extent of the inclined portion is at least 3 mm and certainly less than 30 mm. As to claim 5, the thickness appears to be decreasing from its lower edge to its upper edge. As to claim 7, the sole is clearly seen as having a rearwardly decreasing thickness. As

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to claim 8, the ratio between the maximum and minimum thickness of the sole is "at most" 3.5. As to claim 12, here again, using the thickness of the face as a guide for interpreting the dimensions for the remainder of what is shown in the drawings, it would appear that the upper end of the backside wall is positioned at least 10 mm and certainly less than 30 mm vertically with respect to the horizontal plane. As to claim 14, the ratio of front end-to-rear end thickness for the sole is at least between 0.2 and 3.5, as evidenced by the drawings.

Claims 1, 2, 4 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen ('120). Reference is made to the attached highlight of Figure 3. As to claim 1, note the face portion (13), sole (16) and backside wall having an inclined frontward portion. As to claim 2, the drawing would appear to show a 60-degree angle between the inclined portion and the horizontal plane. As to claim 4, the inclined portion appears to have a substantially constant thickness. As to claim 11, the sole would appear to have a "substantially" constant thickness.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, lines 9 and 10, "so that the distance from said back face gradually decreases from its lower edge to upper edge" is not understood. Is the "distance" that is being measured the distance between the back surface and the backside wall, between

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the back surface and the free upper end, or between the back surface and the inclined frontward portion? Is the applicant referring to the lower and the upper edge of the backside wall or of the inclined frontward portion? Note, the face portion also has a lower edge associated with it and recited in the claims. Clarification is requested.

As to claim 2, this claim depends from claim 1 and thereby shares the indefiniteness of claim 1.

As to claim 3, where is the 3 mm to 30 mm being measured from? Is this distance measured from the horizontal? Or, is this distance being measured from a lower boundary to an upper boundary of the inclined portion?

As to claim 4, this claim depends from claim 1 and thereby shares the indefiniteness of claim 1.

As to claim 5, the location of the lower edge and upper edge is not understood.

As to claim 6, is the minimum thickness being measured at the lower edge and is the maximum thickness being measured at the upper edge? Further, where are the upper and lower edges located with respect to, for example, the horizontal, the free end, the backside wall or the sole? Note, the face has also been described as having a lower edge.

As to claim 7, does the sole portion have a thickness decreasing backwards from the lower edge of the face portion?

As to claim 8, where are the minimum and maximum thickness values being measured from? Is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

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As to claim 9, does the sole portion have a thickness increasing backwards from the lower edge of the face portion?

As to claim 10, where are the minimum and maximum thickness values being measured from? Is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

As to claim 11, is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

As to claim 12, where is the 3 mm to 30 mm being measured from? Is this distance measured from the horizontal?

As to claim 13, it is not clear exactly from what reference point the maximum and minimum distances are being measured.

As to claim 14, where are the front end and rear end located?

Claims 6, 9, 10 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

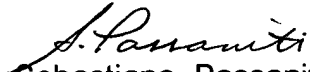
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note wall (124) in Sung. See Figure 5 in Young. Note cavity (22) in Turner. Back wall member (14) in Kobayashi is of interest. Note rear wall (12) in Teramoto. Nagai shows a rear wall of interest. See member (20) in Chen "045).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
March 4, 2005